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10/072,898	02/12/2002	Hannes Eberle	067220-0313074	3570
909 7590 03/01/2010 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102				
EXAMINER				
PHAN, JOSEPH T				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/072,898

**Applicant(s)**

EBERLE ET AL.

**Examiner**

JOSEPH T. PHAN

**Art Unit**

2614

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 27-38, 40-51, 54-65 and 67-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-38, 40-49, 54-65 and 67-76 is/are rejected.
- 7) ☐ Claim(s) 50, 51, 77 and 78 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments with respect to claims **27-38, 40-49, 54-65, and 67-76** have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27 and 54 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 line 14 recites "the recipient of the telephone call" which is unclear if this recipient refers to 'a detected recipient' in line 8 or 'a recipient' in line 13 as it appears there are multiple recipients.

Claim 54 line 15 recites "the detected recipient of the telephone call" which is unclear if this recipient refers to 'a detected recipient' in line 9 or 'a recipient' in line 14 as it appears there are multiple recipients. Appropriate clarification and/or correction is required.

Claims 27 and 54 lines 6-8 recites the two phrases "*, as well as delivery parameters*" and "*, and delivery instructions*" which are unclear and confusing if they refer to line 2 or line 5.

It is not known if the phrase '*, as well as delivery parameters*' relates to line 2 of 'enabling the subscriber to subscribed to' or if it relates to line 5 of 'enabling the subscriber to specify preferences'.

It is not known if the '*, and delivery instructions*' relates to line 2 of 'enabling the

subscriber to subscribed to' or if it relates to line 5 of 'enabling the subscriber to specify preferences'.

There are multiple limitations within lines 3-8 that should be separated by semicolons and proper usage of 'and' to avoid the run-on confusion and make the claimed limitations clear.

Appropriate clarification and/or correction is required.

Claims 27 and 54 lines 15-16 recites "...telephone call detected by the detection means and the delivery instructions" which does not define 'the delivery instructions' detects the telephone call. Appropriate clarification and/or correction is required.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**5. Claims 27-38, 40-49, 54-65, and 67-76 rejected under 35 U.S.C. 103(a) as being unpatentable over Surace et al., Patent #6,144,938 in view of Cox et al, Patent #5,873,032.**

Regarding claims 27 and 54, Surace teaches a system and method for providing service output information to a subscriber of a service, comprising:

service subscription means for enabling at least one subscriber to subscribe to the at least one service that can output personalized information(col.16 lines 23-29) and for enabling the at least one subscriber to specify preferences for the content and presentation of service output information(col.16 lines 40-53), as well as delivery parameters for receiving service output information, the delivery parameters including at least one device to which service output information is to be delivered and delivery instructions based on a detected recipient(col.16 lines 1-15);

service processing means for processing the least one service to generate service output information personalized for the at least one subscriber(col.16 lines 40-53);

Surace does not expressly disclose initiating an outbound telephone call; detection means for detecting a recipient of the telephone call; and delivery means for delivering service output information based on the detected recipient of the telephone call and the delivery instructions.

In a related field of endeavor, Cox discloses means for initiating an outbound telephone call(col.16 lines 30-32); detection means for detecting a recipient of the telephone call(col.16 lines 26-44); and delivery means for delivering service output information based on the detected recipient of the telephone call and the delivery instructions(col.16 lines 26-64).

At the time the invention was made, it would have been obvious to a person of ordinary

skill in the art to modify Surace to include the outbound calling capabilities of Cox. One of ordinary skill in the art would have been motivated to do so as this would allow Surace's system more flexibility and functionality to include the old and well known capabilities of outbound dialing as taught by Cox.

Regarding claims 28 and 55, Surace in view of Cox teaches the system and method of claims 27 and 54, wherein the at least one service is processed when a delivery condition has been met(Cox col.11 lines 24-56).

Regarding claims 29 and 56, Surace in view of Cox teaches the system and method of claims 28 and 55, wherein the delivery condition comprises at least one of a predetermined schedule, or a triggering event(Cox col.11 lines 24-56).

Regarding claims 30 and 57, Surace in view of Cox teaches the system and method of claims 28 and 55, wherein the delivery condition is specified by at least one of a subscriber, or an administrator(Cox col.11 lines 24-56).

Regarding claims 31 and 58, Surace in view of Cox teaches the system and method of claims 27 and 54, wherein the service output information comprises information derived from an on-line analytical processing (OLAP) system(Cox col.11 lines 24-56).

Regarding claims 32 and 59, Surace in view of Cox teaches the system and method of claims 27 and 54, wherein the service output information comprises at least one of static text messages, dynamic content, blended content, sound clips, music, or advertisements(Cox col.12 lines 10-60).

Regarding claims 33 and 60, Surace in view of Cox teaches the system and method of claims 27 and 54, wherein the at least one device comprises a voice-enabled terminal

device(Surace col.16 lines 23-53 or Cox col.16 lines 26-44).

Regarding claims 34 and 61, Surace in view of Cox teaches the system and method of claims 27 and 54, wherein the at least one device comprises a voice-enabled terminal device, and the detected recipient comprises a person(Cox col.16 lines 26-64).

Regarding claims 35 and 62, Surace in view of Cox teaches the system and method of claims 34 and 61, wherein the person is queried for validation information(Cox col.16 lines 26-64 and col.17 lines 12-54).

Regarding claims 36 and 63, Surace in view of Cox teaches the system and method of claims 35 and 62, wherein the validation information is provided by at least one of voice input, or keypad input(Cox col.16 lines 26-64 and col.17 lines 12-54).

Regarding claims 37 and 64, Surace in view of Cox teaches the system and method of claims 27 and 54, wherein the at least one device comprises a voice-enabled terminal device, and the detected recipient comprises a machine(Cox col.16 lines 26-64).

Regarding claims 38 and 65, Surace in view of Cox teaches the system and method of claims 37 and 64, wherein the machine comprises at least one of an answering machine, facsimile machine, or modem(Cox col.16 lines 26-64).

Regarding claims 40 and 67, Surace in view of Cox teaches the system and method of claims 27 and 54, wherein the delivery instructions enable the content of the service output information to be differentiated according to whether the detected recipient comprises a person or a machine(Cox col.16 lines 26-64 and col.17 lines 12-54).

Regarding claims 41 and 68, Surace in view of Cox teaches the system and method of claims 40 and 67, wherein the content of the service output information to be provided when the

detected recipient comprises a machine is reduced from the content of the service output information to be provided when the detected recipient comprises a person(Cox col.16 lines 26-64 and col.17 lines 12-54).

Regarding claims 42 and 69, Surace in view of Cox teaches the system and method of claims 40 and 67, wherein the content of the service output information to be provided when the detected recipient comprises a machine is a message indicating that service output information intended for the at least one subscriber is available(Cox col.16 lines 26-64 and col.17 lines 12-54).

Regarding claims 43 and 70, Surace in view of Cox teaches the system and method of claims 27 and 54, wherein the communication means comprises a call server for establishing communication with the at least one device by initiating a telephone call(Cox col.16 lines 26-64 and col.17 lines 12-54).

Regarding claims 44 and 71, Surace in view of Cox teaches the system and method of claims 43 and 70, wherein the detection means comprises a detection module, the detection module sensing a state of a call pickup sequence of the telephone call(Cox col.16 lines 26-64 and col.17 lines 12-54).

Regarding claims 45 and 72, Surace in view of Cox teaches the system and method of claims 44 and 71, wherein the state of a call pickup sequence comprises a plurality of possible states, and each of the possible states of the call pickup sequence is associated with a detected recipient and the delivery instructions for the detected recipient(Cox col.16 lines 26-64 and col.17 lines 12-54).

Regarding claims 46 and 73, Surace in view of Cox teaches the system and method of



claims 45 and 72, wherein the detection module further comprises a tone detection module, and each tone detected by the tone detection module is associated with at least one of the plurality of possible states(Cox col.16 lines 26-64 and col.17 lines 12-54).

Regarding claims 47 and 74, Surace in view of Cox teaches the system and method of claims 46 and 73, wherein the tone detection module senses at least one of an answering machine tone, a facsimile machine tone, or a modem tone(Cox col.16 lines 26-64 and col.17 lines 12-54).

Regarding claims 48 and 75, Surace in view of Cox teaches the system and method of claims 47 and 74, wherein the state of the call pickup sequence comprises at least one of receipt by a person, receipt by an answering machine, receipt by a facsimile machine, or receipt by a modem(Cox col.16 lines 26-64 and col.17 lines 12-54).

Regarding claims 49 and 76, Surace in view of Cox teaches the system and method of claims 45 and 72 further comprising an interface to an authorization database, the authorization database storing entries associating each of the plurality of possible states with the corresponding detected recipient and the delivery instructions for the detected recipient(Cox col.16 lines 26-64 and col.17 lines 12-54).

***Allowable Subject Matter***

6. Claims 50, 51, 77, and 78 objected to as being dependent upon a rejected base claim but would be allowable if the 112 issues are corrected and if the claims are rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 50, the prior art of record does not expressly disclose, in view of preceding features, wherein the association between the plurality of states and corresponding detected recipients can be altered by an administrator or a subscriber.

Regarding claim 51, the prior art of record does not expressly disclose, in view of preceding features, wherein the telephone call is aborted when the state of the call pickup sequence does not meet at least a minimum authorization criterion stored in the authorization database.

Regarding claim 77, the prior art of record does not expressly disclose, in view of preceding features, wherein the association between the plurality of states and corresponding detected recipients can be altered by an administrator or a subscriber.

Regarding claim 78, the prior art of record does not expressly disclose, in view of preceding features, wherein the telephone call is aborted when the state of the call pickup sequence does not meet at least a minimum authorization criterion stored in the authorization database.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH T. PHAN whose telephone number is (571)272-7544. The examiner can normally be reached on Mon-Fri 9am-6:30pm EST, off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph T Phan/  
Primary Examiner, Art Unit 2614